

Serial No. 10/002,361
Amendment dated January 12, 2004
Reply to Office action of September 12, 2003

Remarks

Claims 1-8 and 10-16 are currently pending in this application. The independent claims are claims 1, 7 and 14. Claims 7, 8, 10 and 11 were rejected under 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claims 1-5, 12 and 13 were rejected under 35 USC §103(a) as being unpatentable over Lueschen in view of Kwan. Claim 6 was rejected under 35 USC §103(a) as being unpatentable over Lueschen in view of Kwan and further in view of Beatty et al. Claims 7, 8, 10 and 11 were rejected as being unpatentable over Lueschen in view of Kwan and further in view of Baum. By this Amendment, Applicant has amended claims 1 and 7 and added new claims 14-16. No new matter has been added by this Amendment. Applicant respectfully submits that as amended, the present application is in condition for allowance.

Claim Objections:

Claims 7, 8, 10 and 11 were rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant has amended claims 7 and 10 to clarify and distinctly claim the subject matter of the invention. Accordingly, the Examiner is requested to withdraw the outstanding rejection as applied to amended claims 7, 8, 10 and 11.

Rejections Under 35 USC §103:

Claims 1-5, 12 and 13 were rejected under 35 USC §103 as being obvious over Lueschen in view of Kwan. Claim 6 was rejected under 35 USC §103 as being obvious over Lueschen in view of Kwan and further in view of Beatty et al. Finally, claims 7, 8, 10, and 11 were rejected under 35 USC §103 as being obvious over Lueschen in view of Kwan and further in view of

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Beaty et al.

A prima facie showing of obviousness based on a combination of multiple prior art references requires the following: (1) a teaching, suggestion or motivation to combine the teachings of multiple references; (2) a reasonable expectation of success; and (3) the combined prior art references must teach or suggest all of the claim limitations. It is respectfully submitted that no prima facie case of obviousness can be sustained as to any of the claims in the present application based on the references cited.

In the obviousness determination, the prior art references must be considered in their "entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984); MPEP §2141.02. "A prior art references that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness..." MPEP §2145. "It is improper to combine references where the references teach away from their combination." *Id.*

It is respectfully submitted that the combinations of references cited by the examiner fail to teach all of the limitations of the independent claims. Claims 1 and 7 have been amended to particularly point out and distinctly claim the invention. Amended claims 1 and 7 and new claim 14 all recite that the circumferential groove in the implant abutment is concave, as is shown in all of the figures of the present application. Lueschen, on the other hand, teaches o-ring abutment comprised of "a hemispherical base 22 and a spherical end 24 separated by a cylindrical spacer 26. The spherical end 24 and the hemispherical base 22 form opposing convex surfaces 28, 30, respectively, adapted to retain the elastomeric o-ring 16." Col. 2, ll. 44-52. In

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the present invention, axial movement of the O-ring is restricted by positioning it in a groove, which extends inwardly from the outer surface of the abutment. In Lueschen, the cylindrical spacer 26 is not a "groove" as the examiner has stated, rather it is a cylindrical member which extends between a spherical and a hemispherical member. It is the shape of the spherical and hemispherical members in Lueschen that restrict axial movement of the o-ring. Because Lueschen does not teach a groove, the combination of Lueschen and Kwan cannot teach each and every element of the independent claims of the instant application. Thus, none of the claims in the present application are obvious.

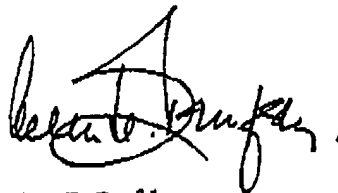
In addition, it would be improper to combine Lueschen with another reference, such as Baum, to reject the claims of the instant application. Lueschen teaches away from the use of a concave groove for retaining an o-ring. *See e.g.* Col. 1, ll. 25-29. One of the stated objects of the Lueschen patent is "to provide such an o-ring attachment system having convex surfaces on an o-ring abutment." Col. 1, ll. 62-64. When considered as a whole, the Lueschen reference cannot properly be combined with any other references to render the present claims obvious.

In light of the foregoing, it is respectfully submitted that all claims are now allowable over the cited prior art. Prompt review and allowance of all claims is believed to be appropriate and is hereby respectfully requested.

A fee of \$55.00 is believed to be due with this amendment. The Commissioner is hereby authorized to charge this any other such fees, or credit any overpayment, to the undersigned attorney's Deposit Account No. 15-0450.

Respectfully submitted,

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